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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/945,116

08/31/2001

Jiandong Shen

CISCP193/3930

2081

22434 7590 02/12/2007

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EXAMINER

SENF, BEHROOZ M

ART UNIT

PAPER NUMBER

2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/945,116

Applicant(s)

SHEN ET AL.

Examiner

Behrooz Senfi

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-33, 40-43 and 45 is/are allowed.
- 6) ☒ Claim(s) 34-39, 44 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant amendment in the specification, filed 01/09/2007 would not be entered. Because it consider as a new matter, broadening the scope of the invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 34 – 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly amended claim 34, a residual error codebook embedded in a computer readable medium, fails to comply with the written description.

For the purpose of art rejection claims 34 – 39 are treated as originally filled.

Response to Amendment

4. Applicant's arguments filed 1/9/2007 with respect to claims 44 and 46 have been fully considered but they are not persuasive.

In response:

Claim 46 is directed to non-statutory functional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a

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computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium. See "Diehr, 450 U.S. at 185-86, 209 USPQ at 8", and therefore, does not result to a practical application, which produces a useful, concrete and tangible results, as required by the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (Official Gazette Notice of 22 November 2005, pages 36 – 38 and 51). Furthermore, The claimed "a computer readable medium including instructions for decoding video data" fails to convey that **"a computer readable medium" encoded with "a computer program and/or computer executable instructions"** as required by the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (Official Gazette Notice of 22 November 2005).

Claim 44 is analogous to claim 46; therefore is non-statutory based on claim 46 and as evidence, page 22, lines 3 - 14 and page 24, lines 17+ of the specification of the instant application.

Claim 34 similar to claim 46 is directed to non-statutory functional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming a signal, which is a nonfunctional descriptive material and therefore, does not result to a practical application, which produces a useful, concrete and tangible results, as required by the Interim Guidelines for Examination of Patent

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Applications for Patent Subject Matter Eligibility (Official Gazette Notice of 22 November 2005, pages 36 – 38 and 51 - 52).

In view of the above, claims 34 – 39, 44 and 46 are still rejected under 35 USC 101 as stated in the previous Office Action (mailed; 12/13/2006).

Allowable Subject Matter

5. Claims 23 – 33 and 45 are allowed over the prior art of the records.

6. The following is an examiner's statement of reasons for allowance: the prior art of the record fails to anticipate or rendered obvious the method and system for encoding video data, comprising: a) generating synthesized video data for a portion of video data using predetermined motion compensation residual errors; b) comparing the synthesized video data with raw video data for the portion to generate a synthesis error for the portion; and selecting a residual error vector index for the portion based on the synthesis error, as claimed in independent claims 23 and 45; and described on page 16 – 17 of the specification of the present application.

Claims 24 – 33 depends from independent claim 23 and therefore these claims as a whole consider allowable.

Note: the allowance is made based on applicant's arguments, presented on 08/08/2006 and Pre-Brief Appeal Conference decision on 09/21/2006.

Claims 1 – 22 and 40 – 43 are allowed for the same reason as indicated in the last Office Action, mailed 12/13/2006.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Behrooz Senfi** whose telephone number is **(571) 272-7339**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mehrdad Dastouri** can be reached on **(571) 272-7418**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Washington, D.C. 20231


Or faxed to:

(571) 273-8300

Hand-delivered responses should be brought to Randolph Building, 401 Dulany Street, Alexandria, Va. 22314.

Any inquiry of a general nature or relative to the status of the application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is **(571) 272-6000**.

B. M. S.



TUNG VO
PRIMARY EXAMINER